

Applicant : Scott Montgomery
Appl. No. : 09/990,605
Examiner : Kambiz Abdi
Docket No. : 703602.6

Remarks

Claims 1-156 have been canceled, claims 157-161 have been amended and claims 162-167 have been added. No new matter has been added by this amendment. Applicant respectfully requests reconsideration in view of the following comments.

As an initial matter, the applicants hereby note that because the handling of this application has been transferred to a new examiner, the applicants have been unable to interview the previous examiner, Mr. Abdi, with regard to the basis of the rejections set forth in the office action. The applicants respectfully submit that the substance of these rejections and citations to the references are not clear enough as to enable the applicants to respond with full confidence that the basis of the rejections are being fully addressed. Furthermore, in at least one instance, the office action fails to make out a prima facie case of invalidity. Nevertheless, the applicants will hereby make a good faith effort to respond in full and will pursue an interview with the new examiner after this submission is filed to evaluate whether a supplemental response is warranted.

Rejections under 35 USC §112

Claims 157 and 161 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The examiner has asserted that "the centralized postage-issuing system" not being part of the USPS or being controlled by the USPS or an official entity has no support in the specification and requested clarification.

On the one hand, the specification makes clear that the centralized postage-issuing computer system may be owned and operated by a postal vendor and therefore may not necessarily be the same entity as the USPS. For instance, the specification states "[e]ach centralized postage-issuing computer system 305/306/307 is owned and operated by a postal vendor and is the principal device that dispenses unique postage indicia to the end user computers 308 over communications links 314 in response to requests by the end user computers 308" (para. [0092] of the corresponding published

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U.S. patent application 2003/01011434). See also, e.g., figures 3, 5, 6, 15, 17, 25 and the text associated therewith. On the other hand, the claims do not preclude the possibility that the "centralized postage-issuing system" may be operated by an entity indirectly controlled or operated by the USPS.

Thus, the applicants respectfully submit that claims 157 and 161 satisfy the requirements of 35 U.S.C. § 112 and respectfully request that the rejection be withdrawn.

Rejections under 35 USC §103

Claims 157-161 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitehouse (U.S. 6,005,945) in view of Sutherland (U.S. 6,349,292). The applicants respectfully traverse.

The applicants respectfully submit that the office action fails to set forth a prima facie case of invalidity in light of the applicants' previous claim amendments and remarks. The most recent office action fails to show how the cited combination of references discloses all of the elements of the claims, even in light of the examiner's comments in response to the applicants' arguments (see page 2 of the office action). Accordingly, the applicants hereby incorporate and reiterate the remarks of the previous response in full.

In addition, the applicants respectfully submit that claims 157 and 160, as amended, are patentable because neither Whitehouse nor Sutherland, taken alone or in combination, discloses a "vendor controlled" centralized postage-issuing computer system "configured to communicate with a centralized master tracking computer system and to receive a unique tracking identification string generated by the centralized master tracking computer system for application to a mail piece such that the tracking identification string is readable independent of the indicium" (emphasis added).

The license ID and serial number relied on by the examiner as disclosing a unique tracking identification string (Whitehouse, col. 13, ll. 38-39) are included within

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the indicium itself and are not an "identification string generated by the centralized master tracking computer system for application to a mail piece such that the tracking identification string is readable independent of the indicium."

In light of this, the cited references altogether fail to disclose a vendor controlled centralized postage-issuing computer system configured to enable a postal authority to verify postage on the mail piece in the manner recited in claim 157 ("*configured to enable a postal authority to verify postage on the mail piece by transmittal of the tracking identification string to the centralized postage-issuing computer system and the centralized postage-issuing computer is configured to, upon receipt of the tracking identification string from the postal authority, retrieve the unique postage indicium from the database and transmit data corresponding to the unique postage indicium to the postal authority*") and claim 160 ("*configured to enable a postal authority to verify postage on the mail piece by transmittal of the tracking identification string to the centralized postage-issuing computer system and the centralized postage-issuing computer is configured to retrieve and validate the unique postage indicium using a public key, and send an indication of whether the unique postage indicium is valid to the postal authority*").

Thus, the applicants respectfully submit that claims 157 and 160 are allowable over the cited references and respectfully request that the rejection under section 103 be withdrawn.

Rejections under 35 USC §102

Alternatively, claims 157-161 were rejected under 35 U.S.C. § 102(e) as being anticipated by Moore (U.S. 5,917,925). Applicants respectfully traverse.

Claims 157 and 160 as amended are patentable over Moore because Moore does not disclose, teach or suggest a "centralized postage-issuing computer system . . . configured to communicate with a centralized master tracking computer system" and "configured to . . . transmit both the unique tracking identification string and the unique postage indicium to the end user computer" (emphasis added).

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In Moore, serial numbers are generated and applied to mailpieces by the local host computer 14 (the "end user computer" according to the construction set forth in the office action) and an indicia printing system 16 (including CPU 27 and marker 20) located downstream to that host computer 14 (see, e.g., FIG. 1b and col. 11, ll. 20-62). In other words, the indicia printing system 16 is only in contact with a single host computer 14. Therefore, neither the host computer 14, the indicia printing system 16 nor a combination of the two can be considered a "centralized master tracking computer system."

Furthermore, because the serial number generation occurs at the host computer 14 and the indicia printing system 16, the control computer 12 does not and cannot transmit the serial number to these entities. Thus, under the construction set forth in the office action, the control computer 12 cannot be "a centralized postage-issuing computer system . . . configured to . . . transmit both the unique tracking identification string and the unique postage indicium to the end user computer."

Thus, the applicants respectfully submit that claims 157 and 160 are allowable over the cited references and respectfully request that the rejection under section 102 be withdrawn.

Conclusion

The applicants respectfully submit that independent claims 157 and 160, and the claims dependent therefrom, are allowable over the cited references. Prompt and favorable action on the merits of the claims is earnestly solicited. Should the Examiner have any questions or comments, the undersigned can be reached at (949) 567-6700.

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The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

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By: _____


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